

REMARKS

Amendments in General

- 1) Reconsideration and allowance of the application as amended is respectfully requested.
- 2) Dependent claims 6, 7, 9, and 13 have been amended to correct typographical errors in the reference to the independent claims upon which they depend.
- 3) These changes do not add new material to the Claims or Specification, but correct minor errors in a manner consistent with the description and claims in the original version. Applicant hereby requests further examination and reconsideration of the Application, in view of the foregoing amendments.

Objection to Claims 6 and 7

- 4) Claims 6 and 7 have been changed to correct typographic errors in the independent claims upon which they depend. In particular, claims 6 and 7 now depend on claim 5.
- 5) These changes do not add new material, but merely correct minor errors as requested by the Examiner.

The rejection of Claims 1-14 under 35 U.S.C. 103:

- 6) The Examiner rejects Claims 1 through 14 under 35 U.S.C. §103(a) as being unpatentable over Tertinek, et al., U.S. Patent 4,232,980, asserting that the flange and multiple attachment point elements that do not appear in Tertinek, but are claimed by the Applicant, are well known in the art. Note that the Examiner cited U.S. Patent 4,323,980 (to Houdard, et al.) which appears to be a typographical error.

Prima Facie Case of Obviousness Not Established:

7) The Applicant asserts that the Examiner has not established grounds for a prima facie case of obviousness. First, any modification of the prior art must be suggested or motivated by the prior art:

“[T]o establish a *prima facia* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claim combination and the reasonable expectation of success must both be found in the prior art, based on applicants’ disclosure. *In Re Vaeck*, 947 F2d. 488, 20 USPQ 2d 1438 (fed. Cir. 1991).” MPEP §706.02(j).

8) This objective evidence must provide **motivation** to modify the prior art.

We have noted that evidence of a *suggestion, teaching, or motivation* to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although “the suggestion more often comes from the teachings of the pertinent references ...” The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. Broad conclusionary statements regarding the teaching of multiple references, standing alone, are not “evidence.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (emphasis added).

9) Even if the prior art may be modified as suggested by the Examiner, the modification is not obvious unless the prior art suggest the **desirability** for the modification. *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992) (“mere fact that prior art may be modified to reflect features of claimed invention does not make the modification, and hence, the claimed invention, obvious unless the desirability of such a modification is suggested by prior art, citing *In re Gordon*, 733 F.2d at 902, 221 USPQ at 1127).

10) The prior art must show reasonable **expectations of success**.

“Both the suggestion and the expectation of success must be founded in the prior art, not in applicant’s disclosure.” *In re Dow Chemical Co. v. American Cyanamid Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

“Obvious to try or to experiment is not sufficient.” *Yamanouchi Pharmaceutical Co., Ltd. v. Marsam Pharmaceuticals, Inc.*, 231 F.3d 1339, 56 USPQ2d 1641 (Fed. Cir. 2000).

The References do not teach all the claim limitations

11) Tertinek teaches an adjustable, pivotable handle for a power trowel. Referring to Fig. 6, the handle pivots about a bolt 142 passing through flattened, apertured ends of the handle 138, through conventional star washers 150, and through a mounting tube 140. A rubber sleeve 148 is placed inside mounting tube 140 to isolate bolt 142. Notwithstanding the presence of the rubber sleeve 148, the handle ends 138 are in direct contact with the star washers 150 and the ends of the mounting tube 140. Conventional star washers are not resilient, and the rubber sleeve 148 does not isolate the handle ends 138 from the mounting tube 140. Vibration is transmitted directly from the frame to the mounting tube, through the star washers, to the handle.

12) In contrast, the Applicant’s independent claims 1 and 5 claim a resilient member mounted so that the “connection between said branch handle and said handle shaft is through said resilient member, wherein said resilient member...does not transmit vibration from said handle shaft to said branch handle.” The resilient member isolates the handle from the mounting flange. Because the handle described in Tertinek is in direct, unisolated contact with the mounting tube, Tertinek does not read on claims 1-14, even when combined with a flange and a second attachment point. Therefore, Applicant’s invention is not obvious in view of Tertinek, and the Applicant respectfully requests allowance of the application.

The cited Reference teaches away from the combination and provides no motivation for making the combination.

13) Assuming, *arguendo*, that the combination contains the claim limitations, the Examiner suggests a skilled artisan would include a lower attachment point with Tertinek to improve stability of the branch handle. However, Tertinek clearly states that the handle is pivotably adjustable: "handle bar 86 may be pivoted vertically about the bolt 142." Star washers 150 and hand wheel 144 "facilitate locking of the handle bar 86 in [an] *adjusted* position..." (emphasis added.) Adding a second attachment point in the manner suggested by the Examiner would prevent pivoting the handle, defeating adjustability, which is the primary purpose of the mounting method described by Tertinek. Since the pivotable handle as described in Tertinek is incompatible with a second attachment point, Tertinek teaches away from adding a second attachment point. Thus, the combination suggested by the Examiner is not obvious, and the Applicant respectfully requests allowance.

The suggested combination does not have a reasonable expectation of success.

14) The handle in Tertinek is in direct contact with star washers, which are in direct contact with the mounting tube. As noted above, this arrangement defeats the purpose of Applicant's invention, which is to isolate the handle from vibration. Adding the flange and second mounting point, as suggested by the Examiner, does not cure this deficiency. On the contrary, adding a second mounting point to Tertinek is likely to increase vibration transmitted to the handle. Because the suggested combination has no expectation of success, the combination is not obvious, and Applicant respectfully requests allowance.

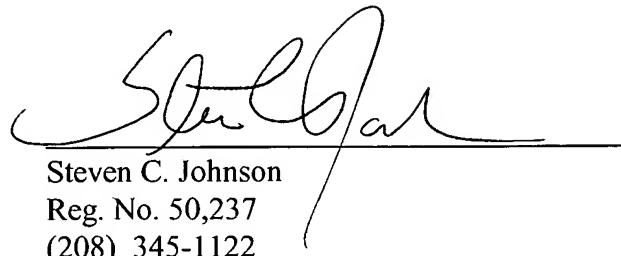
Serial #: 10/773,844
Examiner: Gary S. Hartmann

CONCLUSION

If the Examiner feels it would advance the application to allowance or final rejection, he is invited to telephone the undersigned at the number given below.

Dated this 28th day of October 2005.

Very respectfully,



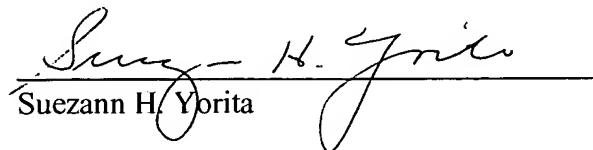
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